

## REMARKS

Entry of the amendments is respectfully requested. Claims 12, 19 and 20 have been amended. Claims 1-21 are pending. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

### **1. Claim Objections**

Claims 12 and 19 were objected to because of informalities. Claim 12 has been amended to change the word "contact" in line 7 to "contacts" and claim 19 has been amended to delete the second period after the word "device" in line 3. Accordingly, withdrawal of the objections is respectfully requested.

### **2. Claim Rejections – 35 U.S.C. § 103**

#### **a. Claims 1-2, 4-8, 11-13 and 15-21**

Claims 1-2, 4-8, 11-13 and 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara et al. ("Hara," U.S. Patent No. 5,938,725) in view of Haynes et al. ("Haynes," U.S. Patent No. 6,442,591) and in further view of Creswell et al. ("Creswell," U.S. Patent No. 6,564,264). Applicants respectfully traverse the rejection. Claims 19 and 20 have been amended to correct a typographical error and now indicate dependency from claim 16.

Independent claim 1 is directed to a method of populating a contact list on a portable device and recites:

extracting contact information from a number of messages  
stored in a memory in the portable device; and

entering the extracted contact information into a contact list maintained by a program operating on the portable device.

Independent claim 12 is directed to a user interface in a portable device configured to facilitate the populating of a contact list and recites, among other limitations:

means for extracting contact information from a number of messages stored in a memory in the portable device; . . .

means for entering the selected contact information into a contact list maintained by a program operating on the portable device.

Independent claim 16 is directed to a processing system and recites, among other limitations:

a storage device . . . having stored there information for configuring the CPU to:

extract contact information from a number of messages stored in a memory in the portable device; and

enter the extracted contact information into a contact list maintained by a program operating on the portable device.

Independent claim 21 is directed to a system for populating a contact list on a portable device and recites:

means for extracting contact information from a number of messages stored in a memory in the portable device; and

means for entering the extracted contact information into a contact list maintained by a program operating on the portable device.

As discussed in the specification, a system and method is provided to populate a contact list on a portable device. See, Specification, page 2, paragraphs 5 and 7 and page 4, paragraph 21. The method advantageously helps to overcome difficulties encountered with entering user contact information on portable devices. See, page 7, paragraph 28. Messages in a database or storage device are scanned by a program residing on memory of the portable device and information is retrieved from the messages. See, page 7, paragraphs 29-30.

There is no motivation to combine Hara with Haynes and Creswell. Hara is directed to a system and method for determining an address for an electronic mail message begin transmitted. See, Hara, col. 1, lines 13-15. Hara specifically teaches that the disclosed system and method are advantageous because a user is not required to access an address book to retrieve an address for an electronic message. In particular, Hara states:

As a result, the user is no longer required to retrieve the address notebook so as to designate the transmission destination address as in the conventional electronic mail transmitting/receiving apparatus. Therefore, the operations and the operation time required to transmit the electronic mail can be considerably reduced.

See, Hara, col. 3, lines 23-28. Hara also states:

Moreover, as to users of electronic mails, they can intuitively retrieve their desired mail address in accordance with the mail address managing (retrieving) manner of the present invention with using the key word, as compared with the mail address managing (relevant divisions) with using the address notebook of the conventional electronic mail transmitting/receiving method. As a consequence, the time and workload required to accomplish the transmission (mail address) of the electronic mail can be shortened.

See, Hara, col. 3, lines 42-50.

Accordingly, one of ordinary skill in the art would not have been provided the motivation to combine Hara with Haynes and Creswell to make the claimed invention. As mentioned, Hara teaches a system designed specifically not to utilize an address book to acquire an address for sending an electronic mail message. In the system of Hara, a user is not concerned with automatically updating an address book or the accessibility of the address book. As taught by Hara, a method is provided to overcome the problems presented by retrieving a mail address from an address notebook that advantageously does not involve accessing an address notebook to find an electronic mail address.

In addition, even if Hara, Haynes and Creswell could be properly combined, the combination of Hara, Haynes and Creswell does not disclose, teach or suggest extracting

information from messages stored in a memory in the portable device or a contact list maintained by a program operating on the portable device. In the Office Action the Examiner states: "Both Hara and Haynes are silent as to if their devices . . . are portable devices. Nonetheless, this feature would have been an obvious modification to the system disclosed by Hara in view of Haynes as evidenced by Creswell." See, Office Action, page 4. However, Creswell does not teach populating a contact list on a portable device as asserted by the Examiner. Rather, Creswell teaches an automatic change server 26 coupled to a message server 20 and a network 12. See, Creswell, Figure 1, col. 3, lines 40-44. A user may use a device such as a wireless handset 15 to send messages to network 12. See, col. 3, lines 27-32. User address book 30, message server 20 and message store 22 communicates with the handset 15 via the network 12. See, Figure 1. Correct address information is used to update a user address book in a directory 30 coupled to the network. See, col. 3, lines 48-50. Accordingly, claims 1, 12, 16 and 21 are believed to be allowable.

Claims 2, 4-8 and 11 depend from independent claim 1 and incorporate all of the limitations of independent claim 1 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 1. Claims 13 and 15 depend from independent claim 12 and incorporate all of the limitations of independent claim 12 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 12. Claims 17-20 depend from independent claim 16 and incorporate all of the limitations of independent claim 16 and are therefore allowable over Hara in view of Haynes and Creswell for, among other reasons, the same reasons as given above with respect to independent claim 16.

Accordingly, claims 1-2, 4-8, 11-13 and 15-21 are believed to be allowable. Withdrawal of the rejection under 35 U.S.C. § 103 and allowance of claims 1-2, 4-8, 11-13 and 15-21 is respectfully requested.

**b. Claims 3, 9, 10 and 14**

Claims 3, 9, 10 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara in view of Haynes and Creswell and in further view of Checkoway et al. ("Checkoway," US Publication 2002/0133554). Applicants respectfully traverse the rejection. Claims 3, 9 and 10 depend from independent claim 1 and incorporate all of the limitations of independent claim 1 and are therefore allowable over Hara in view of Haynes, Creswell and Checkoway for, among other reasons, the same reasons as given above with respect to independent claim 1. Claim 14 depends from independent claim 12 and incorporates all of the limitations of independent claim 12 and is therefore allowable over Hara in view of Haynes, Creswell and Checkoway for, among other reasons, the same reasons as given above with respect to independent claim 12.

Accordingly, claims 3, 9, 10 And 14 are believed to be allowable. Withdrawal of the rejection under 35 U.S.C. § 103 and allowance of claim 3, 9, 10 and 14 is respectfully requested.

**3. Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 8/22/05

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5531  
Facsimile: (414) 297-4900

By Jean M. Tibbetts

Jean M. Tibbetts  
Attorney for Applicant  
Registration No. 43,193